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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/656,039	09/08/2000	Jonathan J. Hull	015358-006400US	4984

20350 7590 02/14/2002

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EXAMINER

LEGREE, TRACY MICHELLE

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 02/14/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/656,039

Applicant(s)

HULL ET AL.

Examiner

Tracy M. Legree

Art Unit

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 is/are allowed.
- 6) ☒ Claim(s) 14-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Reissue Applications*

1. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest *in order to support the consent to a reissue application required by 37 CFR 1.172(a)*. The submission establishing the ownership interest of the assignee is informal. There is no indication of record that the party who signed the submission is an appropriate party to sign on behalf of the assignee. 37 CFR 3.73(b).

A proper submission establishing ownership interest in the patent, pursuant to 37 CFR 1.172(a), is required in response to this action.

2. The submission establishing ownership interest was signed by applicant's attorney. An attorney or agent of record is not authorized to sign a submission establishing ownership interest, unless he/she has been established as being authorized to act on behalf of the assignee. See MPEP § 324.

3. It would be acceptable for a person, other than a recognized officer, to execute a submission establishing ownership interest, provided the record for the application includes a statement that the person is empowered to sign a submission establishing ownership interest and/or act on behalf of the organization.

Accordingly, a new submission establishing ownership interest which includes such a statement above, will be considered to be executed by an appropriate official of the assignee. A separately filed paper referencing the previously filed submission

Art Unit: 2681

establishing ownership interest and containing a proper empowerment statement would also be acceptable.

4. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

5. Claims 17-24 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Regarding **claim 17**, the addition of "the CPU further being configured to reset the camera memory if the camera memory needs additional capacity for storing further images" and the omission of "a return link for sending commands from the receiving station to the <sup>CPU</sup>~~CUF~~", wherein the commands are directions for obtaining further images as needed by the means for image processing", is broader in scope than the original claims.

Regarding **claim 21**, the addition of "the CPU further being configured to reset the cameral memory if the camera memory needs additional capacity for storing further images" and the omission of "a return link for sending commands from the receiving station to the <sup>CPU</sup>~~CUF~~", wherein the commands are directions for obtaining further images

Art Unit: 2681

as needed by the means for image processing", is broader in scope than the original claims.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 18, "wherein the one or more electronic mail messages is provided in MIME format" is not disclosed in the originally filed specification.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maurinus et al. (hereafter Maurinus), U.S. Patent No. 5,606,365 in view of Krebs, U.S. Patent No. 5,557,320.

Regarding **claim 17**, Maurinus discloses a portable image transfer system comprising:

a digital still camera, at a remote station, which captures one or more images in digital form and stores the images in a camera memory; (Abstract; Figure 4B; col. 1, lines 31-34)

a cellular telephone transmitter for communication with a receiving station; (Figures 3 and 4; col. 8, lines 43-46; col. 10, lines 10-15) and

a central processing unit (CPU) coupled to the camera memory and the cellular telephone transmitter, the CPU further being configured to control the cellular telephone transmitter to transmit the output data from the camera memory to the receiving station, (Figure 1; col. 5, lines 7-22), the CPU further being configured to reset the camera memory if the camera memory needs additional capacity for storing further images. (Figure 1; col. 5, lines 5-10)

Maurinus does not disclose that the CPU being configured to control the camera memory to produce output data representing the images formatted as one or more electronic mail messages. Krebs discloses a video mail delivery system that includes means and methods for packaging images as electronic mail messages prior to transmission by a cellular telephone transmitter. (Abstract; Figure 1; col. 3, lines 60-67; col. 4, lines 25-27 and col. 4, lines 41-45)

Maurinus and Krebs are combinable because they are from the same field of endeavor, that is, image transmission systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to have modified Maurinus to

Art Unit: 2681

include packaging images as electronic mail as in Krebs. The motivation for the combination would have been to treat video mail of in the same way as email is treated in computer networks.

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maurinus in view of Krebs as applied to claim 17 above, and further in view of Murphy, U.S. Patent No. 6,028,679.

Regarding **claim 18**, Maurinus in view of Krebs discloses all the limitations of claim 17, but fails to disclose a portable image transfer system wherein the one or more electronic mail messages is provided in MIME format. Murphy is evidence transmitting image data streams as electronic mail messages that are provided in MIME format. (Abstract; col.2, lines 15-30; col. 3, lines 63-67; col. 4, lines 30-35 and lines 40-43) Maurinus and Murphy are combinable because they are from the same field of endeavor, that is, image transmission systems. At the time of the invention it would have been obvious to one of ordinary skill in the art to have modified Maurinus to include electronic mail messages provided in MIME format. The motivation for the combination would have been to allow transmission over the Internet. (col. 2, lines 15-30)

11. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maurinus in view of Krebs as applied to claim 17 above, and further in view of Slaughter, III et al. (hereafter Slaughter), U.S. Patent No. 5,598,536.

Regarding **claim 19**, Maurinus in view of Krebs discloses all the limitations of claim 17, but fails to disclose a portable image transfer system further including means for connecting the receiving station using a predetermined communication protocol. Slaughter discloses a means and method for providing a remote station access to a server station. In particular, Slaughter teaches a remote station's computer that can be loaded with network application software and remote access client software where standard protocol software (e.g., PPP/SLIP with TCP/IP) are used as examples of software applications to be loaded. (col. 5, lines 57-67; col. 6, lines 1-5) Maurinus and Slaughter are combinable because they are from similar problem solving areas, that is, connecting remotely located computer resources. At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Maurinus to include the use of standard protocol software (e.g., PPP/SLIP with TCP/IP). The motivation for the combination would have been to provide a remote user at a remote computer with easy/transparent access to a receiving server and its resources. (see Slaughter: col. 1, lines 8-13 and lines 54-58)

12. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maurinus in view of Krebs as applied to claim 17 above, and further in view of Hassan et al. (hereafter Hassan), U.S. Patent No. 5,550,646.

Regarding **claim 20**, Maurinus in view of Krebs discloses all the limitations of claim 17, but fails to disclose the portable image transfer system wherein the CPU is further configured to connect to an external printing device via the cellular telephone



transmitter. Hassan discloses an image transmission system that includes a remote printing device for printing images processed by a receiving station. (Figures 1 and 2; col. 2, lines 24-28) Maurinus and Hassan are combinable because they are from the same field of endeavor, that is, image transmission systems. At the time of the invention it would have been obvious to one of ordinary skill in the art to have modified Maurinus to include a remote printing device, as in Hassan. The motivation for the combination would have been to provide hard copy for the display of the image data at the remote site. (Hassan: col. 1, lines 47-52)

13. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maurinus in view of Dennison et al. (hereafter Dennison), U.S. Patent No. 5,546,445.

Regarding **claim 21**, Maurinus discloses a portable image transfer system comprising:

a digital still camera, at a remote station, which captures one or more images in digital form and stores the images in a camera memory; (Abstract; Figure 4B; col. 1, lines 31-34)

a cellular telephone transmitter for communication with a receiving station; (Figures 3 and 4; col. 8, lines 43-46; col. 10, lines 10-15)and

a central processing unit (CPU) coupled to the camera memory, to the circuitry, and to the cellular telephone transmitter, the CPU further being configured to control the cellular telephone transmitter to transmit the output data from the camera memory to the receiving station, (Figure 1; col. 5, lines 7-22), the CPU further being configured to

Art Unit: 2681

reset the camera memory if the camera memory needs additional capacity for storing further images. (Figure 1; col. 5, lines 5-10)

Additionally, Maurinus discloses the use of a cellular telephone with the still camera of the image transmission system (Figure 4b) and means for including a location indication with each image. (Figure 1) However, Maurinus does not disclose the portable image transfer system comprising circuitry, coupled to the CPU, to produce information relating to the location of the portable image transfer system wherein the CPU is configured to control the camera to produce output data representing a combination of the images and the location information. Dennison discloses a cellular telephone with a GPS receiver that would provide means for determining a location of the portable image transfer system (Figure 7; col. 4, lines 57-59)

Maurinus and Dennison are combinable because they share a similar problem solving area, that is, wireless communication techniques. At the time of the invention, it would have been obvious to one of ordinary skill in the art to have modified Maurinus to include location determining means, as described in Dennison. The motivation for the combination would have been to provide location information in order to aid the user to make decisions required for the systems operation. (Dennison: Abstract)

14. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maurinus in view of Dennison as applied to claim 21 above, and further in view of Krebs.

Regarding **claim 22**, the combination of Maurinus in view of Dennison discloses all the limitations of claim 21, but fails to disclose the portable image transfer system wherein the output data represents the images and location information in an electronic mail message. Krebs discloses a video mail delivery system that includes means and methods for packaging images as electronic mail messages prior to transmission by a cellular telephone transmitter. (Abstract; Figure 1; col. 3, lines 60-67; col. 4, lines 25-27 and col. 4, lines 41-45)

Maurinus and Krebs are combinable because they are from the same field of endeavor, that is, image transmission systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to have modified Maurinus to include packaging images as electronic mail as in Krebs. The motivation for the combination would have been to treat video mail of in the same way as email is treated in computer networks.

15. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maurinus in view of Dennison as applied to claim 21 above, and further in view of Slaughter.

Regarding **claim 23**, Maurinus in view of Dennison discloses all the limitations of claim 21, but fails to disclose a portable image transfer system further including means for connecting the receiving station using a predetermined communication protocol. Slaughter discloses a means and method for providing a remote station access to a server station. In particular, Slaughter teaches a remote station's computer that can be

Art Unit: 2681

loaded with network application software and remote access client software where standard protocol software (e.g., PPP/SLIP with TCP/IP) are used as examples of software applications to be loaded. (col. 5, lines 57-67; col. 6, lines 1-5) Maurinus and Slaughter are combinable because they are from similar problem solving areas, that is, connecting remotely located computer resources. At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Maurinus to include the use of standard protocol software (e.g., PPP/SLIP with TCP/IP). The motivation for the combination would have been to provide a remote user at a remote computer with easy/transparent access to a receiving server and its resources. (see Slaughter: col. 1, lines 8-13 and lines 54-58)

16. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maurinus in view of Dennison as applied to claim 21 above, and further in view of Hassan et al. (hereafter Hassan), U.S. Patent No. 5,550,646.

Regarding **claim 24**, Maurinus in view of Dennison discloses all the limitations of claim 21, but fails to disclose the portable image transfer system wherein the CPU is further configured to connect to an external printing device via the cellular telephone transmitter. Hassan discloses an image transmission system that includes a remote printing device for printing images processed by a receiving station. (Figures 1 and 2; col. 2, lines 24-28) Maurinus and Hassan are combinable because they are from the same field of endeavor, that is, image transmission systems. At the time of the invention it would have been obvious to one of ordinary skill in the art to have modified

Art Unit: 2681


Maurinus to include a remote printing device, as in Hassan. The motivation for the combination would have been to provide hard copy for the display of the image data at the remote site. (Hassan: col. 1, lines 47-52)

### ***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy M. Legree whose telephone number is (703) 305-3859. The examiner can normally be reached on Mon-Thur and alternate Fri 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (703) 305-4778. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

  
Tracy M. Legree  
Primary Examiner  
Art Unit 2681

TML  
February 8, 2002